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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,956	03/16/2001	Aiko Hanyu	COS-822	7257

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/09/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

ASB

Office Action Summary**Application No.**

09/810,956

Applicant(s)

HANYU ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-24-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-19,21,22,24-30,32,33 and 35-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/2003 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The applicants have amended their claims to recite a melting temperature "of less than about 125 deg C"; this phrase is indefinite since it is unclear where the end point is. It appears that the end point would include values of greater than 125 deg C. The examiner takes the position that this is a crowded art and one working in the art would not know if they were in fact infringing on the applicants' invention.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-11-060833.

The Japanese patent document teaches monolayer heat sealable films made from a metallocene-catalyzed propylene copolymer. The polymers are isotactic in nature and have random comonomer distributions of the comonomer. The materials have good seal / melt properties [0025] and table 1. The comonomers present include those claimed and they are in the claimed amounts. Given the catalytic systems and the starting materials, there is reason to believe that the materials taught would have the claimed physical properties. The applicants have amended their claims to recite a melting temperature “of less than about 125 deg C”, and the prior art has values of 127 and 128. The examiner takes the position that “about 125” would encompass values of a few degrees greater than 125 and, thus encompass the claimed melting point. Furthermore, the melting points of polymers are not sharp so there is experimental error in the values.

The applicants claim oriented films; a film going through an extruder will be oriented to some degree.

It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially

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identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When there is sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

4. Claims 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0-669-348 A-1

The European patent teaches propylene copolymers made by metallocene catalysis, which have desirable sealing characteristics. The materials are used in the formation of monolayer and multi-layer films in which a thin sealant layer (100 microns) is placed on a base layer of polypropylene (500 microns) to yield a film in which the sealant layer composes 20% of the film.

The comonomers present include those claimed and they are in the claimed amounts. Given the catalytic systems and the starting materials, there is reason to believe that the materials taught would have the claimed physical properties. The applicants' specification states that the random copolymers can comprise additional olefin comonomers (e.g. an ethylene/propylene/butene copolymer), page 5, lines 1+. The reference clearly teaches that small amount of ethylene may be present as long as it does not "damage the physical properties of the copolymer (page 3, lines 32+). The melting point of some of the polymers is clearly within the claimed range (table 1, page 11).

It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially

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identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When there is sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0-669-348 A-1 in view of JP-11-060833 or the converse.

The European patent teaches oriented films having a base layer of isotactic polypropylene and a heat sealable propylene layer made by metallocene catalysis. The patent also shows that is common in the art to use a sealable layer on a polypropylene substrate to improve the sealing properties of the film.

The Japanese document teaches random / isotactic propylene copolymers made by metallocene catalysis, which have good seal properties.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the materials taught by JP-11-0608833 as the surface layer in the films taught by EP 0-669-348 A-1, in order to produce heat sealable films. The metallocene

catalyzed polypropylenes taught are functionally equivalent heat sealable materials and this is merely the substitution of one functionally equivalent material for another.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the polymers taught by JP-11-060833 in multilayer and optionally oriented films since it is common in the art to make conventional isotactic polypropylene heat sealable by the addition of a sealable layer.

4. Claims 1, 3, 4, 6-19, 21, 22, 24-30, 32, 33, and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0-669-348

It would have been obvious to one having ordinary skill in the art to have added small amounts of ethylene to the copolymers taught, since they suggest that “

Response to Arguments

5. Applicant's arguments filed 11/24/2003 have been fully considered but they are not persuasive. The applicants have amended the claims to recite: a melting point of less than about 125 deg C and a specific ethylene comonomer concentration. The applicants' arguments with respect to the Japanese Patent 11-060833 are not commensurate with the scope of the instant claims. There is no requirement that the melting points of claimed materials be less than 125 deg C as alleged. The term “about” increases the scope of the term as stated above.

6. The applicants argue that the examiner's use of inherency is misplaced because the Japanese use a different mixture of polymers. The examiner disagrees, the recited patent teaches compositions that comprise a large quantity of metallocene catalyzed polymer and this material would contribute to the properties claimed. They clearly teach films having good antiblocking

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properties and good heat seal properties so the applicants claims directed to these features do not appear to be different. Regarding the xylene extractables, the examiner notes that the claimed values relate only to the polymer, not to the blend so the second material present in the prior art would be irrelevant to these claims. The

7. The gloss or haze values claimed may differentiate the claimed films from those taught by JP-11-06833; but the examiner is not completely convinced by the applicants' arguments. Additional evidence or arguments on this feature may be helpful.

8. The examiner notes that European patent 0 669 348, teaches metallocene catalyzed materials used alone so it would be even closer to the applicants' materials than the Japanese Patent (blend). The material is a single polymer produced by a metallocene catalyst, which corresponds to the material claimed by the applicants.

9. The examiner agrees with the applicants' arguments on page 2 and those rejections have been withdrawn.

Conclusion

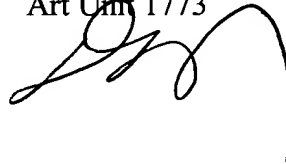
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (571)-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773



dlt

Monday, February 02, 2004